

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64648

Yasuhiro SHINKAI

Appln. No.: 09/863,476

Group Art Unit: 3689

Confirmation No.: 1262

Examiner: Tan D. NGUYEN

Filed: May 24, 2001

For: PRINT ORDER ACCEPTANCE SYSTEM AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated November 28, 2008, Applicant files this Pre-Appeal Brief Request for Review.

Incomplete Office Action/Premature Finality

As an initial matter, Appellants submit that the current finality of the Office Action is improper. In the previous Amendment filed July 17th, 2008, claims 10, 11, and 13 were not amended. Therefore the Examiner could have previously applied the 35 USC 101 rejection to the stated claims in the prior Office Action. However, the Examiner failed to do so. Maintaining the rejection on a final basis is prejudicial to the Appellants. Thus, Appellants submit that the finality of the Office Action is premature, and respectfully request withdrawal of the improper finality.

Claim Rejections Under 35 U.S.C. § 101

The Examiner has rejected Claims 10, 22, 11, 13 and 23 under 35 U.S.C 101, as being directed to nonstatutory subject matter. Independent claims 10 and 11 are both include reference

to apparatus or hardware features. For example, claim 10 recites, “transferring to an image printer” and “instructing a voucher printer, which is separate from the image printer” and with claim 11 which recites, “transferring to an image printer ordered image data.” The results of these methods produce tangible (print) results and thus satisfy all requirements of § 101.

Appellants submit that the rejections should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-5, 16-20, 10, 22, 6-9, 12, 15, 21, 11, 13, 23, and 24 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Winter et al alone or further in view of Sevcik et al. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winter et al and/or Sevcik et al as applied to claims 6-9, and 12, and further in view of Cone et al or Narayanaswamy et al. Claims 6-9, 12, 15, 21, 11, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al and Sevcik et al.

For *at least* the following reasons, Appellants respectfully traverse the rejection.

Appellants submit that claims 1, 6 and 24 are patentable over the prior art. Claim 1 and similarly claims 6 recites, *inter alia*, an order acceptance **means for** digital image data and order information and for transferring the image data and the order information to an image printer. According to the Examination Guidelines for Claims Reciting a “Means or Step Plus Function” limitation, the claim can only be rejected if the prior art performs the same function. The teaching of the function is a prerequisite to any analysis of any structure to perform that function. See MPEP 2183.

In the Final Office Action, the Examiner contends that the claim language, “for transferring the image data and the order information to an image printer” carries no patentable weight as it recites an intended use limitation. The Examiner also contends that a claim directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Appellants respectfully disagree, claims 1, 6 and 24 include “Means or Step Plus Function” in accepting digital image data and order information and in transferring the image data and the

order information to an image printer. Therefore the claim language of claims 1 and 6 carries patentable weight based on MPEP 2183. The means recitations in claim 10 and similarly claim 11 should be afforded patentable weight and deemed allowable. Regarding claim 24, the Examiner appears to misquote the language of the claim. Appellants note this error to clarify the record.

In addition, Appellants submit that the independent claims are patentable because none of the cited art teach “an order acceptance means for accepting digital image data and order information and for transferring the image data and the order information to an image printer” as described in independent claim 1, and analogously in independent claims 6, 10 and 11.

Claims 1 and 10 also describe that the voucher printer and the image printer are separate.

The Examiner cites each of the primary references Winter and Garfinkle for teaching the order acceptance means of the claims. Appellants submit that the rejections are improper for the following reasons.

Winter relates to a printer which is able to generate a combination proof sheet/order form. The proof sheet/order form, as illustrated in Fig. 3A, includes thumbnails I and a bubble area B associated with each image I to order image I. Col. 5, lines 33-60. A user orders information by filling in the appropriate bubble spaces underneath the thumbnail. The sheet becomes scanned by the printer, which outputs prints according to the bubbled in order form. In order to create the proof sheet/order form in the first instance, it is clear that the image data had to have been previously and separately sent to the printer. This is done through a transmission of data information from a camera or from reading the image data from a memory device from the camera. See col. 4, lines 6-19; col. 2, lines 36-55. Thus, Winter does not teach transfer of image data and order information. In addition, in order for the printer to be able to print information from the proof/order sheet, the same printer had to have received the same images on a prior occasion. Col. 5, line 61 to col. 6, line 11.

First, the Examiner incorrectly contends that there are two printers. However, as discussed above, it is clear that there is only a single printer that receives the image data and prints any proof sheets/order forms from receipt of such image data. If there were separate printers, the printer receiving the order from scanning of the scanned images would not have the image data corresponding to that order form. Thus, it is clear that the Examiner's rejection is without support. To the extent that Winter teaches different printer types, each printer becomes alternatively substituted for the single printer, but there can be no separate printers in Winter without significant and unnecessary duplication in effort and resources. The separate printers would render Winter inoperable for its intended purpose. Therefore, Winter cannot explicitly include the two printers and cannot be modified to include two printers.

Second, Winter lacks a means for accepting image order information and image data that then transfers the image data to a printer. To the extent that a printer of Winter can accept the image data and the order information, the image data is not then again transferred to a printer, as the image data is already resident in the printer. To the extent that a memory can receive the image data from a memory card of a camera, that memory does not also receive the order information. There is no explicit and no inherent teaching of the order acceptance system that includes all the features of claim 1. The Examiner's general reliance on Fig. 1, 4 and 7 of Winter is insufficient to meet the features of the claims. Therefore, claim 1 is patentable, and claim 10 is patentable based on analogous recitations. The Examiner has failed to rebut all of these prior submitted arguments.

Furthermore, claims 6 and 11 also include features regarding the transfer or receipt of the image data and order information together, and thus are patentable for the second reason discussed above in relation to Winter.

Regarding claims 19 and 20, the Examiner contends that they are taught inherently in the teachings of Winter and/or Winter/Sevcik. Appellants disagree as claim 19 recites, "order acceptance means accepts the digital image data and order information synchronously in a single

transaction.” Winter teaches providing a proof sheet after the images have been accepted and Sevcik teaches getting a quotation after submitting the images, therefore making it impossible to submit the images and the order information simultaneously. Claim 20 recites, “the thumbnail images of the voucher correspond only to those images printed as part of said order”. This is not taught, as Winter teaches printing of all images on the proof, and then the user selecting which images to print (Fig. 3). Sevcik does not teach the printing of a voucher. Therefore Claims 19 and 20 are not taught by Winter and/or Winter/Sevcik. Appellants also disagree with the Examiners classification of the claims as Manner of operating. The claims disclose an order acceptance means and disclose its function. As stated, in a “Means plus Function” claim the functions carry patentable weight.

The rejection over Garfinkle is similarly deficient. Garfinkle relates to a distributed image ordering system such that an image uploaded at location A can be separately accessed, or ordered, at location B. Col. 4, lines 57-67 and Abstract.

The Examiner contends that Figs. 1, 6 and 8 teach all features of claim 6. However, a review of Fig. 1 and supporting text shows that an image upload location A, and a separately formed access (order) point B. Therefore, there is no location which receives both the image data and the order information because A and B are separate locations. Therefore, the Examiner’s general reliance on Garfinkle does not support the rejections. Claim 11 is patentable for analogous reasons, and the remaining claims are patentable based on their dependencies.

It is further noted that the additional references of Sevcik, Cone and Narayanaswamy do not make up for any of the deficiencies of the primary references.

Respectfully submitted,
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Date: March 2, 2009